

## REMARKS

### **Reconsideration And Allowance Are Respectfully Requested.**

Claims 1, 3, 4, 5, 7, 8 and 10 are currently pending. Claims 2, 6 and 9 have been canceled. Claims 1, 4 and 8 have been amended. New claim 11 has been added. No new matter has been added. Reconsideration is respectfully requested.

Applicant would first like to thank Primary Examiner Hotaling for the courtesies extended during the interview conducted on March 10, 2004. During the course of this interview, U.S. Patent Application Publication No. 2002/0016674 to Rudow et al. (Rudow) and U.S. Patent No. 5,507,485 to Fisher (Fisher) were discussed as they relate to the prior art of record. Unfortunately, no agreement was reached regarding patentability after discussing the pending claims, proposed amendments and prior art in substantial detail. With this in mind, Applicant has endeavored to further amend the pending claims in an effort to overcome the prior art of record.

With regard to the rejections based upon prior art, claim 4-7 stand rejected under 35 U.S.C. §102(e) as being anticipated by Rudow. Further, claims 1-3 and 8-10 stand rejected as being unpatentable over Rudow et al. in view of Fisher.

With regard to the rejections under 35 U.S.C. § 102, the law governing rejections under §102 dictates that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v Union Oil Co of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be

arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

As mentioned above, claims 4-7 stand rejected under 35 U.S.C. §102(e) based upon the disclosure of Rudow. As amended, claim 4 now define that selected coordinates must be measured and the coordinate information “consists of a first coordinate relating to the front of each of the hole greens and a second coordinate relating to the middle of each of the hole greens wherein the limited number of coordinates make it possible for an individual to quickly store the required coordinates”. In addition, claim 4 now requires that the coordinate information be loaded within a personal digital assistant cradle and that the displayed distance on the personal digital assistant be based “only upon the predefined coordinate information as loaded onto the personal digital assistant via the cradle”.

Rudow fails to disclose the method steps outlined in amended claim 4. In particular, Rudow does not measure selected coordinates consisting of a first coordinate relating to the front of each of the hole greens and a second coordinate relating to the middle of each of the hole greens. Rather, Rudow relies upon a vast array of measurements in providing golfers with information relating to a golf course. In addition, Rudow at no point discloses storing the coordinate information within a personal digital assistant cradle and loading the coordinate information within a personal digital assistant. Rudow does disclose the possibility for the utilization of a mobile unit, but nowhere discloses the use of personal digital assistant in conjunction with a cradle for uploading course information to the personal digital assistant.

As to claims 5 and 7, Rudow does not disclose walking the course during the step of measuring and taking at most 36 coordinate measurements.

As such, it is Applicant's opinion that amended claims 4, 5 and 7 overcome the rejection under 35 U.S.C. §102 and Applicant respectfully requests that the rejection be withdrawn.

Further, and with regard to new claim 11, nothing in the prior art discloses or suggests charging a fee for the coordinate information downloaded to the PDA. While prior art systems may charge a fee for the use of GPS equipment they are not concerned with the sale of information. As such, this claim is further believed to be allowable over the prior art.

With regard to the rejections under §103, the Office Action suggests that it would have been obvious to modify Rudow based upon the disclosure of Fisher. In particular, the Office Action states "Rudow discloses all of the instant application with respect to a personal digital assistant... with the exception of a cradle... In an analogous golf computer display system to Fisher there is disclosed a IC card for uploading into a personal digital assistant the specifics of a golf course... The Examiner contends that the cradle is used for the transfer of information and since a means is disclosed in both the Rudow and Fisher references to transfer information the specific cradle could be the IC card or any well known wired or wireless cradle used for the transfer of information such as that used by the Palm Pilot or the like." This obviousness rejection is respectfully traversed in view of the proceeding amendments and the remarks which follow.

In establishing the law governing obviousness-type rejections, the Supreme Court in *Graham v John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary

considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquires may have relevancy. . . This in not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

With the foregoing in mind, the U.S. Patent & Trademark Office has determined that a prima facie case of obviousness is established by meeting three basic criteria. First, the Examiner must show some suggestion or motivation to modify the reference or to combine reference teachings. Second, the Examiner must show a reasonable expectation of success in modifying the primary reference based upon the teachings of the prior art. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Support for the proposed modification and the reasonable expectation of success must be found in the prior art. MPEP 706.02(j). It has further been determined that "[w]here a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." See *In re Hoch*, 428 F.2d 1341, 1342 n.3 166 USPQ 406, 407 n. 3 (CCPA 1970).

In presenting the obviousness rejection, the Office Action agrees that Rudow fails to disclose the claimed cradle, but suggests that Fisher teaches the utilization of an IC card for uploading into a personal digital assistant the specifics of a golf course. However, and as presented in amended claims 1 and 8, as well as previously discussed method claim 4, Applicant has developed a system for providing golfers with distance information in a convenient and cost effective manner.

Specifically, Applicant appreciates that many golf facilities are unwilling to pay the additional expense associated with employing elaborate systems such as those disclosed by Rudow and Fisher. Applicant also appreciates that a convenient and cost effective system is needed within the golf industry such that all golfers can take advantage of current GPS technology without “breaking the bank”. With this in mind, Applicant has developed a system which relies upon a limited number of coordinate points; specifically, the front of each of the hole greens and the middle of each of the hole greens.

Applicant’s system allowing a golf course to be up and running with the ability to provide a GPS distance service without incurring all of the expense of systems such as those disclosed by Rudow and Fisher. In particular, and as presented in the amended claims, the system employs a personal digital assistant including a GPS function, a memory, a processor and an input/output. The system further employs a cradle shaped and dimensioned for receiving the personal digital assistant and transferring information thereto. The cradle includes a memory storing information relating to coordinates on a golf course and an input/output for transmitting the information to the personal digital assistant, wherein the coordinates stored within in the memory of the cradle consists only of a first coordinate relating to the front of each of the hole greens and a second coordinate relating to the middle of each of the hole greens. In this way, the cradle is capable of transferring a mere 36 coordinates to the personal digital assistant for use in identifying the golfer’s distance to both the front and the middle of the hole greens on each hole of the golf course.

The claimed system stands in stark contrast to the elaborate, expensive and difficult to implement systems disclosed by Rudow and Fisher. In order for the cited prior art to read upon the pending claims, it is be necessary for the Office to prove the obviousness of providing a cradle

which transfers coordinate information consisting only of a first coordinate relating to the front of each of the hole greens and a second coordinate relating to the middle of each of the hole greens. It is Applicant's opinion the use of such a coordinate information database is neither disclosed nor suggested by Rudow, Fisher or the other prior art of record in the present application.

As discussed above, the Office must show a suggestion or motivation to modify the reference or to combine reference teachings. The Office must also show support for the proposed modification and the reasonable expectation of success. The information must be found in the prior art.

These standards are not met by the current prior art of record. Specifically, nothing in the prior art discloses or suggests the possibility of providing a golf distance system which only relies upon coordinate information concerning the front and middle of each green of a golf course. As such, any argument that it would in fact be obvious to simply "strip down" the system proposed by Rudow is unsupported by the prior art and contrary to the mandates of the MPEP.

Specifically, Rudow and the other references of record in the present application disclose elaborate and expensive systems because they are not concerned with the development of a system which may be readily utilized on golf courses unwilling or unable to incur the expense of an elaborate GPS system. To suggest that it would have been obvious to modify Rudow such that only front and middle green coordinates are provided is entirely contrary to the teachings of Rudow. Rudow neither contemplates such a system nor suggests how such a system would work. Absent a suggestion to modify Rudow as proposed by the Office Action or a suggestion as to how someone would modify Rudow as proposed in the Office Action, it is Applicant's opinion that the amended

claims are not obvious based upon the prior art of record and Applicant respectfully requests that the rejections under 35 U.S.C. §103 be withdrawn.

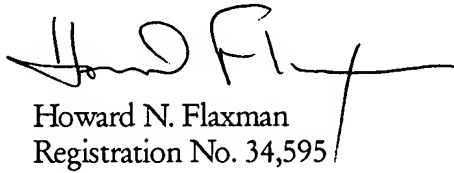
In addition, the Office Action suggests that Fisher discloses the utilization of a cradle in transferring information to a personal digital assistant. Applicant respectfully disagrees. As the Office Action indicates, Fisher does disclose the utilization of an IC card for uploading information to a golf computer. This, however, is not equivalent to the utilization of a cradle commonly employed with a personal digital assistant. An IC card requires that information be downloaded from a main computer to the IC card, that the IC card be withdrawn from the main computer, that the IC card be transferred to a second computer, and that the information on the IC card be uploaded to the second computer. In contrast, a cradle merely requires a personal digital assistant be placed upon the cradle and the information be directly uploaded to the personal digital assistant via the cradle. The vast difference between IC cards and personal digital assistant cradles is supported by the classification system of the U.S.P.T.O. which clearly places these products in very different classifications.

Further, Fisher does not suggest a two coordinate system as claimed in accordance with the present system.

As such, and further to the reasons presented above regarding the coordinate information, it is Applicants' opinion that the prior art fails to disclose or suggest the Applicant system as presented in the amended claim and Applicant respectfully requests that all outstanding rejections be withdrawn.

It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested. If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,



Howard N. Flaxman  
Registration No. 34,595

WELSH & FLAXMAN LLC  
2450 Crystal Drive, Suite 112  
Arlington, VA 22202  
Telephone No. (703) 920-1122

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